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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,323	01/31/2002	Carl W. Gilbert	329.1001-U	9839
20311	7590	06/17/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP			OH, TAYLOR V	
475 PARK AVENUE SOUTH			ART UNIT	
NEW YORK, NY 10016			PAPER NUMBER	

1625

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/066,323	Applicant(s) GILBERT ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 16, 22, 24, 25 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 9, 14, 24 and 31 is/are rejected.
- 7) ☒ Claim(s) 2-4, 7, 8, 10-12, 16, 22 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments with respect to claims 1-12, 14, 16, 22, 24-25 and 31 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 1-12, 14, 16, 22, 24-25 and 31 are under consideration.

Claims 1, 5-6, 9, 14, 24 and 31 have been rejected.

Claims 2-4, 7-8, 10-12, 16, 22 and 25 are objected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-6, 9, 14, 24 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrases "B is a first active moiety, reactive group moiety or a polymer" and "A is a second active moiety" are recited. The expressions of "B" and "A" are vague and indefinite. There is no distinction between "a first active moiety" and "a second active moiety" in view of an absent criteria. In the compound claim, the first active moiety and reactive group moiety have no meaning in terms of structural components in the formula; they need definite chemical structural formulas. Furthermore, the term "a polymer" is unclear because "a polymer" is a compound that consists of very large molecules made up of many repeating subunits; there is uncertainty as to what the repeating

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subunit may be for the claimed compound. Therefore, an appropriate correction is required.

In claims 5 and 24, the phrase "L-B comprises" is recited. The expression is vague and indefinite because the word "comprises" would mean that there other additional components besides the only L-B. Therefore, an appropriate correction is required.

In claim 6, the term "R₁₁ comprises a polyalkylene oxide residue" is recited. The expression is vague and indefinite because the word "comprises" would mean that there other additional components besides the only R₁₁. Furthermore, in the compound claim, the type of alkylene subunit needs to be identified in the definite chemical structural formula. Therefore, an appropriate correction is required.

In claim 14, the phrase "R₁₂ and R₁₃ are independently electron donating or electron withdrawing groups" is recited. The expression is vague and indefinite. The claim does not describe what the electron donating and the electron withdrawing groups are in the formula. Therefore, an appropriate correction is required.

In claim 31, the phrases "A is a second active moiety", "L₁ is a moiety containing a functional group capable of reacting with the NHR₂₂ and "B₁ is

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polymers, biologically active materials and polymeric supports” are recited. The expressions of A, L₁, and B₁ are vague and indefinite. In the compound claim, the second active moiety and the moiety containing the functional group have no meaning in terms of structural components in the formula ; also, there are many functional groups which may not work with the NHR₂₂ ; they need definite chemical structural formulas. Furthermore, the terms “ polymers, biologically active materials and polymeric supports” are unclear because there is uncertainty as to what each of polymers, biologically active materials and polymeric supports can be in the formula. “polymers” are compounds that consist of very large molecules made up of many repeating subunits; there is an uncertainty as to what the repeating subunit may be for the claimed compound. Therefore , an appropriate correction is required.

Allowable Subject Matter

Claims 2-4, 7-8,10-12, 16, 22 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The close prior art is the copending Application No. 10/066,306.

The rejection of Claims 1-12, 14, 16, 22, 24, 25 and 31 provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 8-16, 26 and 34 of copending Application No. 10/066,306 has been withdrawn due to the Terminal Disclaimer filed on 4/8/2004.

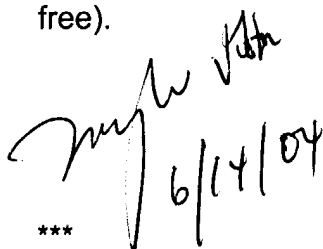
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Therefore, applicant's current invention would not have been obvious to the skilled artisan in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


6/14/04
